

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

### **II. Disposition of Claims**

Claims 1-46 are pending in this application. Claims 47-126 were cancelled in a previous response.

Claims 1, 11, 13, 15, 24, 25, 29, and 39 have been amended herein. These amendments are supported by the specification as filed.

Claims 1-8, 10, 17-20, and 35-37 stand rejected under 35 U.S.C. § 102(b). Claims 15 and 38-45 stand rejected under 35 U.S.C. § 103(a). The Office Action has objected to claims 9, 11-14, 16, 21-34, and 46.

### **III. Rejections of Claims**

#### **A. Rejections of Claims Under 35 U.S.C. § 102(b)**

Claims 1-8, 10, 17-20, and 35-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,390,195 to Nguyen *et al.* (“*Nguyen*”). With respect to these rejections, the Office Action states:

Nguyen et al discloses a method of controlling the production of particulates from a well by emplacement of a cement sheath within the well bore penetrating a subterranean formation. The permeable cementing slurry may be positioned in the annulus between a perforated pipe and the open well bore. Nguyen et al further provides the cement with a particulate cross-linked gel containing an internal breaker which causes the gel to break “whereby vugs and channels are formed in the set cement column” (col. 2, lines 42-51; col. 3, lines 33). For example, one of the breakers may comprise the enzyme hemicellulase. Hence, it is deemed that the particulate cross-linked gel inherently comprises “a degradable material”, as called for in claim 1 and 6, by virtue of the enzyme attack or cleavage of the hydratable polymer component, such as hydroxyalkylcellulose, of the particulate cross-linked gel.

(Office Action at page 2.)

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2005). In this response, Applicants have amended claim 1 to recite that the degradable material is selected from a group of materials listed in pending claims

11-14, which the Office Action stated would be allowable if written in independent form (*see* Office Action at page 5). *Nguyen* does not disclose any of these degradable materials, but rather discusses the use of a cement slurry that comprises a cross-linked gel and an internal breaker to form vugs and channels in the set cement. (*See Nguyen* at col. 2, ll. 42-51.)

Applicants therefore respectfully assert that *Nguyen* does not anticipate claim 1, as amended herein, and thus that claim is patentable over *Nguyen*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitation of the claim to which it refers,” and since claims 2-8, 10, 17-20, and 35-37 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**B. Rejections of Claims Under 35 U.S.C. § 103(a)**

1. Rejection of Claim 15

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of U.S. Patent No. 4,210,455 to Metcalf *et al.* (“*Metcalf*”). To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2005). However, as discussed in Section III.A. above, *Nguyen* does not teach or suggest any of the degradable materials listed in claim 1, as amended herein. Nor does *Metcalf* teach or suggest any of these degradable materials. Rather, *Metcalf* discloses hydraulic cement slurries that comprise certain set retarders and are compatible with certain fluid loss additives. (*See Metcalf* at Abstract.) Therefore, since neither *Nguyen* nor *Metcalf* teaches any of the degradable materials listed in claim 1, as amended herein, the combination of *Nguyen* and *Metcalf* cannot obviate claim 1. Since claim 15 depends from claim 1, this dependent claim also incorporates these limitations that neither *Nguyen* nor *Metcalf* teaches or suggests, and thus is similarly allowable. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of this rejection.

2. Rejections of Claims 38-43

Claims 38-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of U.S. Patent Application Publication No. 2003/02218832 by Reddy *et al.* (“*Reddy*”). To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142

(2005). However, as discussed in Section III.A. above, *Nguyen* does not teach or suggest any of the degradable materials listed in claim 1, as amended herein. Nor does *Reddy* teach or suggest any of these degradable materials. Rather, *Reddy* discloses certain gas-generating additives, foam stabilizing surfactants, and methods of use in well treatment fluids. (See *Reddy* at Abstract.) Therefore, since neither *Nguyen* nor *Reddy* teaches any of the degradable materials listed in claim 1, as amended herein, the combination of *Nguyen* and *Reddy* cannot obviate claim 1. Since claims 38-43 depend, either directly or indirectly, from claim 1, these dependent claims also incorporate these limitations that neither *Nguyen* nor *Reddy* teaches or suggests, and thus are similarly allowable. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

3. Rejection of Claim 44

Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of U.S. Patent No. 6,904,971 to Brothers (“*Brothers*”). To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2005). However, as discussed in Section III.A. above, *Nguyen* does not teach or suggest any of the degradable materials listed in claim 1, as amended herein. Nor does *Brothers* teach or suggest any of these degradable materials. Rather, *Brothers* discloses the use of certain cement compositions that may have improved corrosion resistance and methods of use in subterranean operations. (See *Brothers* at Abstract.) Therefore, since neither *Nguyen* nor *Brothers* teaches any of the degradable materials listed in claim 1, as amended herein, the combination of *Nguyen* and *Brothers* cannot obviate claim 1. Since claim 44 depends from claim 1, this dependent claim also incorporates these limitations that neither *Nguyen* nor *Brothers* teaches or suggests, and thus is similarly allowable. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of this rejection.

4. Rejection of Claim 45

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of U.S. Patent No. 6,578,630 to Simpson *et al.* (“*Simpson*”). To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2005). However, as discussed in Section III.A. above, *Nguyen* does not teach or suggest any of the degradable materials listed

in claim 1, as amended herein. Nor does *Simpson* teach or suggest any of these degradable materials. Rather, *Simpson* discloses certain expandable tubular apparatuses and methods of use in subterranean well bores. (See *Simpson* at Abstract.) Therefore, since neither *Nguyen* nor *Simpson* teaches any of the degradable materials listed in claim 1, as amended herein, the combination of *Nguyen* and *Simpson* cannot obviate claim 1. Since claim 45 depends from claim 1, this dependent claim also incorporates these limitations that neither *Nguyen* nor *Simpson* teaches or suggests, and thus is similarly allowable. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of this rejection.

#### **IV. Objections to Claims**

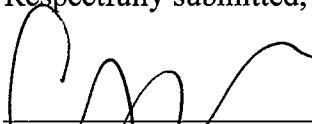
The Office Action has objected to claims 9, 11-14, 16, 21-34, and 46 as being dependent upon a rejected base claim, but has stated that these claims “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” (Office Action at page 5.) As Applicants have shown the base claim (*i.e.*, independent claim 1), as amended herein, to be allowable, Applicants respectfully assert that claims 9, 11-14, 16, 21-34, and 46 as presented herein are allowable.

#### **SUMMARY**

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicits timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no additional fees due in association with this filing of this Response. However, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order No. 063718.0334, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



---

Carey C. Jordan  
Registration No. 47,646  
BAKER BOTTS L.L.P.  
One Shell Plaza  
910 Louisiana  
Houston, TX 77002  
Telephone: 713.229.1233  
Facsimile: 713.229.7833  
Email: Carey.Jordan@bakerbotts.com

Date: August 7, 2006